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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,162	11/10/2000	Guillermo J. Tearney	187718/US - 475387-00245	3219
30873 7590 10/09/2007 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 250 PARK AVENUE NEW YORK, NY 10177			EXAMINER KISH, JAMES M	
			ART UNIT 3737	PAPER NUMBER
			MAIL DATE 10/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/709,162	Applicant(s) TEARNEY ET AL.	
	Examiner James Kish	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 68-136 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 68-73, 75, 79-82 and 86-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Wurster (US Patent No. 4,141,362). Wurster discloses a laser endoscope equipped both with an observation optic and a laser beam. A deflection mirror is connected to a beam path of the observation optic on the proximal side for a laser beam in order to allow the operator to direct the laser beam into the area of observation in order to treat the area (column 1, line 57 through column 2, line 4). A prism is also used within the endoscopic assembly (column 3, lines 11-12). It is possible to reduce the diameter of the endoscope to a minimum thereby opening up the areas of applications in very small body hollows and/or cavities (column 1, lines 39-42 and column 3, lines 1-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 74, 76-78, 84-85, 89-102, 104-107, 109-116, 118-128 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurster in view of Fritch et al. (US Patent No. 4,607,622). Wurster discloses a laser endoscope equipped both with an observation optic and a laser beam, as described in the rejection of claims 68-73, 75, 79-82 and 86-87. However, Wurster fails to provide optical fibers. Fritch teaches a fiber optic ocular endoscope attached to a TV monitor to provide the operator with a display of the interior of the eye. At least two fiber bundles are used for illumination purposes and a third lumen is used for providing optical therapy (column 2, line 63 through column 3, line 19 and column 5, lines 1-13). The size to permit entry into the eye through an incision varies in size from 250 microns to approximately 3 millimeters (column 5, lines 30-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide optic fibers for illumination channels as taught by Fritch in order to bending of the endoscope to provide viewing of areas beneath the iris and on the side of the iris that were otherwise impossible to view or reach before (column 2, lines 29-40).

Claims 83, 88, 103, 108, 117, 129 and 131-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurster in view of Fritch et al. and further in view of

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Olinger et al. (US Patent No. 3,941,121). Wurster combined with Fritch is discussed above in the rejection of claims 74, 76-78, 84-85, 89-102, 104-107, 109-116, 118-128 and 130. However, these references fail to provide a fluid displacement arrangement. Olinger teaches a needle endoscope including a hollow needle of about 18-gauge (see Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Wurster and Fritch into the tip of a needle, as taught by Olinger, because as described by the references the dimensions allow for such placement without modification. Furthermore, it would have been obvious to combine in order to provide operative visual supervision of a treatment procedure performed through an operative channel of the needle and which is small enough to be universally acceptable for introduction into previously inviolate tissue area without resorting to open surgery techniques (column 2, lines 56-62).

Conclusion


Also see Chikama (US Patent No. 3,856,000).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Kish whose telephone number is 571-272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK


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